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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,467	02/17/2004	Gerald M. Goupil JR.	DP-309551	1398

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EXAMINER

BOLES, DEREK

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,467

Applicant(s)

GOUPIL ET AL.

Examiner

Derek S. Boles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15-23, 26-29 and 31-33 is/are rejected.
- 7) ☒ Claim(s) 8-14, 24, 25 and 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/17/04; 3/16/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 15 and 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Higashihara (5,653,630). See fig. 5, col. 6, lines 26-39, **203** for the substrate, **201** for the elastomeric layer and **204** for the silicone top layer. Regarding claim 15, see **20a** to **20c**. Regarding claim 21, see **17** to **18**. Regarding claims 22 and 26, see **19**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim(s) 2 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higashihara in view of Schaal et al. (6,482,884). Higashihara discloses all of the limitations of the claim(s) except for the silicone topcoat layer being formed from a silicone-containing composition comprising a vinyl and methoxy functional dimethyl siloxane. Schaal et al. discloses the presence of a silicone-containing composition comprising a vinyl and methoxy functional dimethyl siloxane. See col. 9, lines 36-67. Hence, one skilled in the art would find it obvious to modify the system of Higashihara to include the silicone-containing composition

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comprising a vinyl and methoxy functional dimethyl siloxane of Schaal et al. for the purpose of durability.

Regarding claims 4-6 and 28, Higashihara discloses the claimed invention except for the elastomeric layer comprising a silicone rubber. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an elastomeric layer with silicone rubber and/or various other material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim(s) 7, 18, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higashihara in view of Carroll, Jr. (5,192,609). Higashihara discloses all of the limitations of the claim(s) except for the elastomeric layer comprising urethane. Carroll, Jr. discloses the presence of an elastomeric layer comprising urethane. See col. 9, lines 40-43. Hence, one skilled in the art would find it obvious to modify the system of Higashihara to include the elastomeric layer comprising urethane of Carroll, Jr. for the purpose of increased durability. Regarding claims 18 and 33, see col. 11, lines 29-32

Claim(s) 16, 17, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higashihara in view of Inoue et al. (5,326,315) Higashihara discloses all of the limitations of the claim(s) except for woven or non-woven, glass-based fibers. Inoue et al. discloses the presence of a woven or non-woven, glass-based fibers. See col. 6, lines 2-8. Hence, one skilled in the art would find it obvious to modify the system of Higashihara to include the woven or non-woven, glass-based fibers of Inoue et al. for the purpose of increased durability.

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Allowable Subject Matter

Claims 8-14, 24, 25 and 30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The provided references are representative of the state of the art that is applicable to the applicant's invention. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derek S. Boles at (571) 272-4872 or supervisory patent examiner Ehud Gartenberg at (571) 272-4828.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D.S.B.


DEREK S. BOLES
PRIMARY EXAMINER
GROUP 3700

3/5/06